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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,574	11/13/2000	Kuk Ho Bae	P-142	4534
34610	7590	03/02/2005	EXAMINER	
FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153			BROCKETTI, JULIE K	
			ART UNIT	PAPER NUMBER

3713

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/709,574

Applicant(s)

BAE ET AL.

Examiner

Julie K Brockett

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 22, 2004 has been entered.

### ***Claim Objections***

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 is to a game server system that utilizes the device of claim 2. Claim 3 is an independent claim and needs to be written as such. The device of claim 2 is not being further limited by claim 3 therefore it is improper. Applicant can simply correct this by merely inserting the limitations of claim 2 into claim 3 so that it is clearly in independent form.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-8, 14, 16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Tagawa et al., U.S. Patent No. 4,866,515.** Tagawa discloses a game service system including a game service-transmitting device. The transmitting device comprises a multiplexer configured to convert image information and audio information of a broadcast signal, a game program, and game-related information into a transport stream. A transmitting unit is configured to channel-code, modulate, amplify and transmit the transport stream (See Tagawa Fig. 1; col. 1 lines 55-67; col. 2 lines 1-2, 20-32; col. 5 lines 10-34, 43-51; col. 10 lines 26-29). A game receiving device comprises a tuning unit configured to receive the image and audio information of the broadcast signal, a game program ordered by a user, and game-related information, and to select either the image and audio information corresponding to a broadcast channel desired by the user, or the game program ordered by the user. A common game interface module is configured to demodulate a selected game program and game-related information, to error

correct the demodulated information, to download the game program and store the game program in a game memory portion of the common game interface unit for access by a user when desired, and to process the game-related information (See Tagawa col. 2 lines 3-19, 33-49; col. 5 lines 1-7, col. 6 lines 62-67) [claim 1]. A game service transmitting device and system comprises a multiplexer configured to convert image and audio information of a broadcast signal, a game program, and game-related information into a transport stream. A transmitting unit is configured to channel-code the transport stream and to modulate, amplify, and transmit the transport stream to a receiving unit when requested by a user (See Tagawa abstract, col. 1 lines 60-67; col. 2 lines 1-49; col. 5 lines 7-52) [claims 2, 3]. The game server is configured to receive a game-ordering signal indicating a game desired by a user and to provide the selected game program and game-related information (See Tagawa col. 6 lines 55-67) [claim 4]. The game service receiving device comprises a tuning unit configured to receive image and audio information of a broadcast signal, a game program ordered by a user, and game-related information and configured to select either the image and audio information corresponding to a channel desired by a user or a game program ordered by the user. A common game interface module is configured to demodulate a selected game program and game-related information, to error correct, download and process the demodulated game program and game-related information and to store the game program for access by a user when desired (See Tagawa col. 2 lines 3-19,

33-49; col. 5 lines 1-7, 55-67; col. 6 lines 1-67) [claim 5]. It is inherent to the system of Tagawa that the common interface module includes a downloader configured to download the game program ordered by the user using the game-related information [claim 6]. For example, the game is downloaded from the master controller computer to the personal computer at the interface by a downloading device. The common game interface module includes a game memory configured to store the downloaded game program and a CPU configured to execute the stored game program (See Tagawa col. 6 lines 62-67; Fig. 1) [claim 7]. The CPU is configured to execute the game program upon receipt of a controlling command input through a user interface (See Tagawa col. 7 lines 37-40) [claim 8]. Tagawa further discloses a game service transmitting method comprising converting image and audio information of a broadcast signal, a game program, and game-related information into a transport stream. The transport stream is coded, amplified and modulated over a certain channel (See Tagawa col. 1 lines 55-67; col. 2 lines 1-55) [claim 14]. In the game service receiving method, a game list is extracted comprising game-related information from a transport stream that includes image and audio information of a broadcast signal, a listing of game programs and game-related information. A game program is downloaded by a user according to the game-related information and the program is stored in a game memory portion of a receiving device and the game is executed (See Tagawa col. 6 lines 55-67) [claim 16]. A broadcast and receiving device comprises a downloader

configured to receive a broadcast signal of a channel and to download a game program ordered by a user using game-related information encoded with the broadcast signal. Game memory is configured to store the downloaded game program for access by a user when desired. A CPU is configured to execute the stored game program in response to a user request (See Tagawa col. 6 lines 55-67) [claim 20].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al., in view of Tarr et al., U.S. Patent No. 5,935,004.** Tagawa discloses a game service receiving device comprising a processor configured to receive an input from a user interface, and to output a either a first control signal to select a broadcast signal of a channel desired by a user or a second control signal to order a game desired by the user (See Tagawa col. 6 lines 55-67). A common game interface module is configured to receive the first control signal and to demodulate a broadcast signal of a channel selected by the user, a game program and game related information,

wherein the common game interface module is also configured to error correct download, store, and process the demodulated game-related information so as to allow a user to view the selected channel or execute the selected game (See Tagawa col. 2 lines 3-19, 33-49; col. 5 lines 1-7, 55-67; col. 6 lines 1-67) [claim 9]. A common interface host is configured to provide a resource for processing the game program and the game-related information (See Tagawa Fig. 1) [claim 10]. It is inherent to the system of Tagawa that the common interface module includes a downloader configured to download the game program ordered by the user using the game-related information [claim 11]. For example, the game is downloaded from the master controller computer to the personal computer at the interface by a downloading device. The common game interface module includes a game memory configured to store the downloaded game program and a CPU configured to execute the stored game program (See Tagawa col. 6 lines 62-67; Fig. 1) [claim 12]. The CPU is configured to execute the game program upon receipt of a controlling command input through a user interface (See Tagawa col. 7 lines 37-40) [claim 13]. Tagawa lacks in disclosing a modem.

Tarr et al. teaches of using a modem configured to receive a control signal to order a game desired by the user and outputs a corresponding game ordering signal (See Tarr col. 3 lines 22-27; col. 4 lines 60-62) [claim 9]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cable modem in the invention of Tagawa so as to



receive signals from different locations thereby being able to provide the users with more programming choices.

**Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al., in view of Vance, U.S. Patent No. 6,267,672 B1.**

Tagawa lacks in disclosing adding a new game to the list. Vance teaches of adding a new game program and game-related information to a previously established game list (See Vance col. 2 lines 58-63) [claim 15]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to install new games desired by a user. By installing new games desired by a user, the system is giving its customers the games in which they want to play. Therefore, if the games the customers want are implemented into the system, these individuals will remain customers. Furthermore, the level of excitement in the games and system remains high, which increases the number of customers.

**Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al., in view of Okamoto, U.S. Patent No. 5,489,103.** Tagawa lacks in disclosing having a user request a game when the game is not included in the extracted game list. Okamoto teaches that an extracted game list is displayed to a user on a screen (See Okamoto Fig. 5). The user requests a game program from a transmitting party (See Okamoto Fig. 6). It is clear that the user may request a game program from the transmitting party when the game program selected is not included in the displayed game

list. In the system of Okamoto, a user enters the number of the game they wish to play, it is clear that a player may enter an invalid number [claims 17 & 19]. For example, if there are only games 1-5, the player can still enter the number 9 and an error may be generated or no game is provided.

Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users in the system of Tagawa to select games that are not included on a displayed list by going to a channel that is not on the list. This is similar to a user selecting a television channel on their TV set that they do not get image information. Nothing stops a user from attempting to get a game that is not available. It is a matter of curiosity to select game or channels that are not available and see whether or not they are truly not available.

**Claims 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al., in view of Hawkins, U.S. Patent No. 6,005,561.** Tagawa lacks in disclosing using packet identifiers. Hawkins et al. teaches of an interactive information delivery system in which game-related information comprises a packet identifier (PID) configured to identify a packet of a game program ordered by a user and a game list (See Hawkins et al. col. 13 lines 42-55; Fig. 8) [claim 18]. It would have been obvious at the time the invention was made to include packet identifiers. By using packet identifiers, one can determine the location within the broadcast stream of the game requested by a

user. Consequently, locating and retrieving the game program is easier and faster.

### ***Response to Amendment***

It has been noted that claims 1, 2, 5-7, 12, 14-16 and 20 have been amended.

### ***Response to Arguments***

Applicant's arguments, filed December 22, 2004, with respect to the rejection(s) of the claim(s) under Okamoto and Reed have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view Tagawa et al., U.S. Patent No. 4,866,515.

### ***Citation of Relevant Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Freeman et al., U.S. Patent Application No. 2002/0129374 A1.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone

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number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Julie K Brockett  
Examiner  
Art Unit 3713